

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77319089
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION (no change)	
ARGUMENT(S)	
<p>In the Office Action, the Examining Attorney continued and made final the refusal to register Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the basis that Applicant's mark PURCHASE REWARDS is merely descriptive of the goods described in the application.</p> <p>Applicant respectfully requests that the Examining Attorney remove the 2(e)(1) objection in light of the comments set forth below. Moreover, Applicant has filed a Notice of Appeal and a Request to Suspend the Appeal along with this request for reconsideration.</p> <p><u>Applicant's Mark is NOT Primarily Merely Descriptive of Applicant's Services</u></p> <p>It is well established that in order for a mark to be refused registration under Section 2(e)(1), it must be primarily merely descriptive of the goods. The term "merely" means "only" and a mark is "merely descriptive" only if, when considered with its particular goods, it does nothing but describe those goods. T.M.E.P. § 1209.01. On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to infer what goods the term implies, or if the term conveys multiple meanings, then the term is suggestive rather than merely descriptive. <u>Ex parte Consolidated Products Co.</u>, 76 U.S.P.Q. 73, 74 (Comm'r of Patents 1948). See e.g., <u>Blisscraft of Hollywood v. United Plastics Co. et. al.</u>, 131 U.S.P.Q. 55 (2nd Cir. 1961); <u>Ex parte Candle Vase, Inc.</u>, 105 U.S.P.Q. 73, 74 (Comm'r of Patents 1965) (the mark CANDLE VASE not merely descriptive of flower holder adapted for fitting around the base of a candle since the mark "stimulates speculation as to its intended meaning and leaves the mind in doubt"); <u>In re Scott Paper Co.</u>, 180 U.S.P.Q. 283 (T.T.A.B. 1973) (the mark MICRO-WIPES for small paper wipes held "merely suggestive"); and <u>In re TMS Corp. of the Americas</u>, 200 U.S.P.Q. 57, 58-59 (T.T.A.B. 1978) (the mark THE MONEY STORE is not merely descriptive of financial goods business).</p> <p>As the wording PURCHASE REWARDS applies a suggestive and imaginative twist, a certain amount of imagination, thought and perception are required for the average prospective purchaser to reach a conclusion as to the specific type of goods offered in connection with Applicant's mark. In fact, because a potential "consumer must use more than a small amount of imagination to make the</p>	

association, the mark is suggestive and not descriptive, and entitled to registration.” Rodeo Collection Ltd. v. West Seventh, 2 U.S.P.Q.2d 1204, 1206-1207 (9th Cir. 1987) (the mark RODEO COLLECTION not merely descriptive for shopping center goods).

In support of this position, Applicant directs the Examining Attorney’s attention to In re Shutts, 217 U.S.P.Q. 363, 364-65 (T.T.A.B. 1983), in which the Trademark Trial and Appeal Board (the “Board”) held that SNO-RAKE is not merely descriptive of a long-handled tool used to scrape snow. The Board found that the mark SNO-RAKE does not evoke an impression and understanding of applicant’s goods. The Board noted that “[t]he concept of mere descriptiveness . . . must relate to general and readily recognizable word formulations and meanings, either in a popular or technical usage context.” Id. at 364.

Applicant also directs the Examining Attorney’s attention to In re Pennwalt Corp., 173 U.S.P.Q. 317 (T.T.A.B. 1972) (“Penwalt”). In Penwalt, the Examining Attorney refused registration of DRI-FOOT as a trademark for an antiperspirant/deodorant for feet on the grounds that the mark was merely descriptive of the result of the use of the product. The Board held that DRI-FOOT is not the usual or normal manner in which the purpose of an antiperspirant or deodorant for the feet would be described. The Board stated that although DRI-FOOT is highly suggestive, it is not merely descriptive.

Likewise, Applicant submits that the mark PURCHASE REWARDS does not evoke an impression and understanding of Applicant’s services. Further, as is discussed in more detail below, PURCHASE REWARDS is not the usual or normal manner in which Applicant’s services would be described. Instead, a certain amount of imagination, thought and perception are required for the average prospective purchaser to reach a conclusion as to the type of services offered in connection with Applicant’s mark. In addition, the mark “stimulates speculation as to its intended meaning and leaves the mind in doubt.”

For example, in In re Rank Organisation Ltd., 222 U.S.P.Q. 324, 326 (T.T.A.B. 1984), the Board found the term LASER suggestive of loudspeakers that were designed and tested with laser technology, observing that just because a term “is capable of being analyzed does not render that term merely descriptive.” See also Plyboo America Inc. v. Smith & Fong Co., 51 U.S.P.Q.2d 1633, 1641 (T.T.A.B. 1999) (the “ability to ascertain that the mark ‘PLYBOO’ is a blend taken from elements of the words ‘plywood’ and ‘bamboo’ does not establish that consumers would understand such mark as merely describing”).

“[T]he fact that a term may be descriptive of certain types of goods does not establish that it is likewise descriptive of other types of goods, even if the goods are closely related.” In re The Stroh Brewery Co., 34 U.S.P.Q.2d 1796, 1797 (T.T.A.B. 1995) (holding that although the term “virgin” might be descriptive of non-alcoholic mixed drinks, it is not descriptive of non-alcoholic malt beverages). See also <http://ttabvue.uspto.gov/ttabvue/ttabvue-91125739-OPP-51.pdf>, in which the Board found SEXY not descriptive of hair products. Likewise, Applicant’s mark is not merely descriptive of its services.

The Mark is a Non-Descriptive Composite Mark

It is well recognized that the combination of two descriptive elements can result in a composite mark that is non-descriptive and registerable. T.M.E.P. § 1209.01(b) (4); See In re Sweet Victory, Inc., 228 U.S.P.Q. 959, 961 (T.T.A.B. 1986) (descriptive combination of GLACE, which means ice or frozen, and LITE creates non-descriptive composite mark).

Similarly, Applicant submits that the commercial impression of the terms found in its mark, when used in combination, are greater than its parts and results in a suggestive trademark. See Taco Cabano Int'l v. Two Pesos, Inc., 932 F.2d 1113, 1119, 19 U.S.P.Q. 1253, 1258 (5th Cir. 1991), aff'd, 505 U.S. 763 (1992).

Moreover, in In re Ada Milling Co., 98 U.S.P.Q. 267, 269 (C.C.P.A. 1953), the Court of Customs and Patent Appeals reversed the Examining Attorney's refusal to register the mark STARTGROLAY on the grounds that the mark was merely descriptive of poultry feed, despite the fact that the evidence of record indicated that the words "start," "grow," and "lay" were commonly used to indicate various types of poultry food. In reaching this decision, the Court of Customs and Patent Appeals explained:

Here appellant has so combined three words into a unitary notation as to result in a mark which in our opinion, may suggest but does not necessarily describe the character of its goods. While it is, of course, true that if the mark were dissected, the words "Start," "grow," and "lay" might well be descriptive of the characteristics of various types of poultry feed, it is our belief that when the mark is viewed in its entirety, as it is viewed in the market place, it is capable of distinguishing applicant's goods from those of others.

Applicant also directs the Examining Attorney's attention to In re Colonial Stores, Inc., 394 F.2d 549, 157 U.S.P.Q. 382 (C.C.P.A. 1968), where the mark SUGAR & SPICE for bakery products was held not to be merely descriptive even though the two words from which it was composed, "SUGAR" and "SPICE," were each descriptive of the products.

Applicant further directs the Examining Attorney's attention to Ex parte Consolidated Products Co., 76 U.S.P.Q. 127 (Comm'r of Pat. 1958), where the Commissioner found that the mark KAFF-A used in connection with vitamins for calves was suggestive rather than merely descriptive of the goods. Id. at 128. The Commissioner quoted an earlier case involving the mark MOUSE SEED for a mouse poison which indicated that "when two words are coupled together to make 'mouse seed' there is no immediate meaning made by a suggestion to the mind as to what the term could mean and the two words used in conjunction cease to be descriptive and become suggestive." Id.

Additionally, Applicant directs the Examining Attorney's attention to Philip Morris, Inc. v. R.J. Reynolds Tobacco Co., 207 U.S.P.Q. 451 (T.T.A.B. 1980), where the Board determined that the mark SOFT SMOKE was suggestive of smoking tobacco. In reaching its decision, the Board stated:

The descriptiveness of the term "smoke" has been acknowledged by applicant, and it is obvious from the dictionary definitions of "soft" that it may have some application to smoking tobacco. However, it is established that a combination of descriptive words may result in an arbitrary unitary term that may function as a trademark.

Id. at 455.

If the mark imports information directly, it is descriptive, but if it requires some operation of the imagination to connect it to the goods, it is suggestive. Id. at 456 (quoting, Union Carbide v. EverReady, Inc., 188 U.S.P.Q. 623 (7th Cir. 1976)). The Board went on to say:

Viewed in this light, it is our view that the term SOFT SMOKE suggests some

characteristic of applicant's smoking tobacco, a suggestion that may not be clear or immediately perceptible or even be the same for each user of applicant's tobacco.

Id. at 456.

Moreover, Applicant directs the Examining Attorney's attention to Bausch & Lomb Inc. v. Nevitt Sales Corp., 26 U.S.P.Q.2d 1275 (W.D.N.Y. 1993), where the Court stated that although "the words 'ray' and 'ban' are descriptive when read separately; it does not diminish the distinctiveness of the Ray-Ban mark read as a whole." Id. at 1278. The Court concluded that "when the two descriptive words 'ray' and 'ban' are joined together by a hyphen, they gain a new meaning, one that is only suggestive of the product the name identifies." Id.

The Board and the courts often conclude that composite marks are not merely descriptive. See Worthington Foods, Inc. v. Kellogg Co., 14 U.S.P.Q.2d 1577 (S.D. Ohio 1990) (the mark HEARTWISE not descriptive for foods that are "wise for the heart"); Citibank, N.A. v. Citibanc Group, Inc., 222 U.S.P.Q. 293 (11th Cir. 1984) (the mark CITIBANK only suggestive of banking services); Scientific Applications, Inc. v. Energy Conservation Corp., 195 U.S.P.Q. 379 (Georgia D.C. 1977) (the mark THE HOMEFOAMERS not descriptive of home foam insulation services); In re Reynolds Metals Co., 178 U.S.P.Q. 296 (C.C.P.A. 1973) (the mark BROWN-N-BAG is suggestive for plastic cooking bags); In re Realistic Co., 169 U.S.P.Q. 610 (C.C.P.A. 1971); Blisscraft of Hollywood v. United Plastics Co., 294 F.2d 694 (2nd Cir. 1961) (the mark POLY PITCHER only suggestive of pitcher made of polyethylene); In re Delaware Punch Co., 186 U.S.P.Q. 63 (T.T.A.B. 1975) (the mark THE SOFT PUNCH not descriptive for noncarbonated soft drink); and In re National Tea Co., 144 U.S.P.Q. 286 (T.T.A.B. 1965) (the mark NO BONES ABOUT IT not descriptive for fresh pre-cooked ham).

In fact, in In re Bed-Check Corp., 226 U.S.P.Q. 946, 947 (T.T.A.B. 1985), the Board reversed a merely descriptive refusal of SENSORMAT for "apparatus for detecting the presence, restlessness, or absence of a patient in a bed, consisting of electrical sensing pad placed under the patient, and control unit." In reversing the Examining Attorney's descriptiveness objection, the Board stated that "[w]hile it may be said that each of the component parts of [applicant's] mark has some descriptive significance as applied to applicant's pressure-sensitive pads, it seems to us that applicant's mark comprises two nouns which when combined form a highly suggestive but non-descriptive whole." Similarly, as explained in Applicant's Brief and discussed below, Applicant has blended three terms to form a suggestive mark.

The Board made precisely this point in In re WasteBid.com, Inc., Ser. No. 76/001,834, available at <http://des.uspto.gov/Foia/ReterivePdf?fiNm=76001834-09-29-2004.pdf&system=ttabis> (T.T.A.B. September 29, 2004). In WasteBid.com, the Board reversed a merely-descriptive refusal of WASTEBID.COM and explained that "[t]he combination of the two individually descriptive words, WASTE and BID, into WASTEBID results in an incongruous compound term. A prospective purchaser must mentally reorder the words and add words to make sense of the phrase, i.e., to understand that the services involve submitting bids to dispose of waste." (page 7).

In a similar case, In re Cleaner's Supply, Inc., Ser. No. 75/582,044, available at <http://www.uspto.gov/web/offices/com/sol/foia/ttab/2eissues/2003/75582044.pdf> (T.T.A.B. January 23, 2003), the Board reversed a merely-descriptive refusal of BRIDAL KEEPSAFE for "cardboard and paper boxes for storing gowns after dry cleaning." The Examining Attorney argued that the mark BRIDAL KEEPSAFE was merely descriptive because the applicant's boxes were used to keep bridal

gowns safe. However, the Board found the mark suggestive (pages 4-5):

[A]lthough these individual elements "bridal," "keep" and "safe" have some descriptive significance, we cannot say, based on the meanings of the individual words, that the combination BRIDAL KEEPSAFE is merely descriptive of applicant's goods. . . In this case, some degree of thought or imagination must be used to get from BRIDAL KEEPSAFE to the concept "keeps bridal gowns safe," a phrase which would, of course, be merely descriptive of applicant's boxes. That is, there is an element of incompleteness which we believe an individual encountering the mark must interpret in order to arrive at the conclusion that applicant's boxes are used for holding wedding gowns after cleaning.

Applicant submits that this same rationale applies in determining the registerability of the mark PURCHASE REWARDS and that the same degree of information is required by consumers in relation to this mark, as is required by customers to perceive the meanings of the marks in the cases cited above. Because Applicant's mark consists of a composite mark in connection with Applicant's services, whose import cannot be grasped without a "mental pause," the mark as a whole is suggestive rather than merely descriptive.

A Descriptive Connotation Does Not Preclude a Mark From Being Suggestive

It is well established that suggestiveness is not a bar to registration on the Principal Register. In this regard, T.M.E.P. § 1209.01(a) provides in pertinent part: "a designation does not have to be devoid of all meaning relative to the goods or services to be registrable." It is not prohibited that a mark have the capacity to draw attention to what the product is or what its characteristics are. The C.C.P.A. has held that a suggestive, and therefore registrable, mark may even go so far as to possess a "descriptive connotation" that conveys an impression of the goods. "The simple presence of that type of descriptive connotation, like the presence of suggestiveness, will not preclude registration where the mark is not merely descriptive of the goods." The Coca-Cola Co. v. Seven-Up Co., 497 F.2d 1351, 182 U.S.P.Q. 207, 209 (C.C.P.A. 1974) (holding UNCOLA not merely descriptive of noncola soft drinks). Thus, even if Applicant's mark does arguably convey an impression of Applicant's services, or the characteristics thereof, by virtue of a "descriptive connotation," the Coca-Cola case makes it clear that such a connotation shall not preclude registration of the mark. In fact, "often the best trademarks are highly suggestive, and it is well settled that a valid trademark may be highly suggestive." Minnesota Mining and Mfg. Co. v. Johnson and Johnson, 172 U.S.P.Q. 491, 492 (C.C.P.A. 1972).

Doubt is Resolved in Favor of Publication

Any doubts as to the mere descriptiveness of a term are to be resolved in Applicant's favor and in favor of publication of the mark for opposition. See In re Grand Forest Holdings Inc., 78 U.S.P.Q.2d 1152 (T.T.A.B. 2006); In re Grand Metro. Foodservice Inc., 30 U.S.P.Q.2d 1974 (T.T.A.B. 1994). "Where reasonable men may differ, it has been the practice to resolve such doubt in an applicant's behalf and publish the mark for opposition." In re The Gracious Lady Serv., Inc., 175 U.S.P.Q. 380, 382 (T.T.A.B. 1972). Accordingly, because there is at least some significant doubt in this case as to the mere descriptiveness of Applicant's applied-for mark, Applicant respectfully requests that the Examining Attorney withdraw the refusal and approve the application for publication.

The Mark is Entitled to Registration

Finally, Applicant notes that even if the Examining Attorney does not accept Applicant's arguments set forth above, Applicant submits that the mark is entitled to registration on the Supplemental Register.

Conclusion

Applicant submits that it has responded to all issues raised in the Office Action. If the Examining Attorney has any questions, he is encouraged to contact the undersigned.

GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS	035
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DESCRIPTION

PROVIDING AN ELECTRONIC COMPUTER DATABASE TO ENCOURAGE CUSTOMERS TO MAKE ADDITIONAL PURCHASES AT THE POINT OF TRANSACTION

FILING BASIS	Section 1(b)
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GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS	035
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DESCRIPTION

providing an electronic computer database for use by retail store operators at the point of return or the point of transaction to enable the retailer to determine based upon the customer's return history, purchase history and returned items, whether the customer should receive a special offer that encourages the customer to continue shopping at the retail store or return to the store at a later time

FILING BASIS	Section 1(b)
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SIGNATURE SECTION

DECLARATION SIGNATURE	The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the <i>Trademark Rules of Practice</i> .
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RESPONSE SIGNATURE	/Stacey R. Halpern/
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SIGNATORY'S NAME	Stacey R. Halpern
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SIGNATORY'S POSITION	Attorney of Record, California Bar Member
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DATE SIGNED	03/03/2009
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AUTHORIZED SIGNATORY	YES
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CONCURRENT APPEAL NOTICE FILED	YES
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FILING INFORMATION SECTION

SUBMIT DATE	Tue Mar 03 17:01:11 EST 2009
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TEAS STAMP

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PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. 77319089 has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

In the Office Action, the Examining Attorney continued and made final the refusal to register Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the basis that Applicant's mark PURCHASE REWARDS is merely descriptive of the goods described in the application.

Applicant respectfully requests that the Examining Attorney remove the 2(e)(1) objection in light of the comments set forth below. Moreover, Applicant has filed a Notice of Appeal and a Request to Suspend the Appeal along with this request for reconsideration.

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As the wording PURCHASE REWARDS applies a suggestive and imaginative twist, a certain amount of imagination, thought and perception are required for the average prospective purchaser to reach a

conclusion as to the specific type of goods offered in connection with Applicant's mark. In fact, because a potential "consumer must use more than a small amount of imagination to make the association, the mark is suggestive and not descriptive, and entitled to registration." Rodeo Collection Ltd. v. West Seventh, 2 U.S.P.Q.2d 1204, 1206-1207 (9th Cir. 1987) (the mark RODEO COLLECTION not merely descriptive for shopping center goods).

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For example, in In re Rank Organisation Ltd., 222 U.S.P.Q. 324, 326 (T.T.A.B. 1984), the Board found the term LASER suggestive of loudspeakers that were designed and tested with laser technology, observing that just because a term "is capable of being analyzed does not render that term merely descriptive." See also Plyboo America Inc. v. Smith & Fong Co., 51 U.S.P.Q.2d 1633, 1641 (T.T.A.B. 1999) (the "ability to ascertain that the mark 'PLYBOO' is a blend taken from elements of the words 'plywood' and 'bamboo' does not establish that consumers would understand such mark as merely describing").

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Similarly, Applicant submits that the commercial impression of the terms found in its mark, when used in combination, are greater than its parts and results in a suggestive trademark. See Taco Cabano Int'l v. Two Pesos, Inc., 932 F.2d 1113, 1119, 19 U.S.P.Q. 1253, 1258 (5th Cir. 1991), aff'd, 505 U.S. 763 (1992).

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Here appellant has so combined three words into a unitary notation as to result in a mark which in our opinion, may suggest but does not necessarily describe the character of its goods. While it is, of course, true that if the mark were dissected, the words "Start," "grow," and "lay" might well be descriptive of the characteristics of various types of poultry feed, it is our belief that when the mark is viewed in its entirety, as it is viewed in the market place, it is capable of distinguishing applicant's goods from those of others.

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Id. at 455.

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Viewed in this light, it is our view that the term SOFT SMOKE suggests some characteristic of applicant's smoking tobacco, a suggestion that may not be clear or immediately perceptible or even be the same for each user of applicant's tobacco.

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Moreover, Applicant directs the Examining Attorney's attention to Bausch & Lomb Inc. v. Nevitt Sales Corp., 26 U.S.P.Q.2d 1275 (W.D.N.Y. 1993), where the Court stated that although "the words 'ray' and 'ban' are descriptive when read separately; it does not diminish the distinctiveness of the Ray-Ban mark read as a whole." Id. at 1278. The Court concluded that "when the two descriptive words 'ray' and 'ban' are joined together by a hyphen, they gain a new meaning, one that is only suggestive of the product the name identifies." Id.

The Board and the courts often conclude that composite marks are not merely descriptive. See Worthington Foods, Inc. v. Kellogg Co., 14 U.S.P.Q.2d 1577 (S.D. Ohio 1990) (the mark HEARTWISE not descriptive for foods that are "wise for the heart"); Citibank, N.A. v. Citibanc Group, Inc., 222 U.S.P.Q. 293 (11th Cir. 1984) (the mark CITIBANK only suggestive of banking services); Scientific Applications, Inc. v. Energy Conservation Corp., 195 U.S.P.Q. 379 (Georgia D.C. 1977) (the mark THE HOMEFOAMERS not descriptive of home foam insulation services); In re Reynolds Metals Co., 178 U.S.P.Q. 296 (C.C.P.A. 1973) (the mark BROWN-N-BAG is suggestive for plastic cooking bags); In re Realistic Co., 169 U.S.P.Q. 610 (C.C.P.A. 1971); Blisscraft of Hollywood v. United Plastics Co., 294 F.2d 694 (2nd Cir. 1961) (the mark POLY PITCHER only suggestive of pitcher made of polyethylene); In re Delaware Punch Co., 186 U.S.P.Q. 63 (T.T.A.B. 1975) (the mark THE SOFT PUNCH not descriptive for noncarbonated soft drink); and In re National Tea Co., 144 U.S.P.Q. 286 (T.T.A.B. 1965) (the mark NO BONES ABOUT IT not descriptive for fresh pre-cooked ham).

In fact, in In re Bed-Check Corp., 226 U.S.P.Q. 946, 947 (T.T.A.B. 1985), the Board reversed a merely descriptive refusal of SENSORMAT for "apparatus for detecting the presence, restlessness, or absence of a patient in a bed, consisting of electrical sensing pad placed under the patient, and control unit." In reversing the Examining Attorney's descriptiveness objection, the Board stated that "[w]hile it may be said that each of the component parts of [applicant's] mark has some descriptive significance as applied to applicant's pressure-sensitive pads, it seems to us that applicant's mark comprises two nouns which when combined form a highly suggestive but non-descriptive whole." Similarly, as explained in Applicant's Brief and discussed below, Applicant has blended three terms to form a suggestive mark.

The Board made precisely this point in In re WasteBid.com, Inc., Ser. No. 76/001,834, available at <http://des.uspto.gov/Foia/ReterivePdf?fiNm=76001834-09-29-2004.pdf&system=ttabis> (T.T.A.B. September 29, 2004). In WasteBid.com, the Board reversed a merely-descriptive refusal of WASTEBID.COM and explained that "[t]he combination of the two individually descriptive words, WASTE and BID, into WASTEBID results in an incongruous compound term. A prospective purchaser must mentally reorder the words and add words to make sense of the phrase, *i.e.*, to understand that the services involve submitting bids to dispose of waste." (page 7).

In a similar case, In re Cleaner's Supply, Inc., Ser. No. 75/582,044, available at <http://www.uspto.gov/web/offices/com/sol/foia/ttab/2eissues/2003/75582044.pdf> (T.T.A.B. January 23, 2003), the Board reversed a merely-descriptive refusal of BRIDAL KEEPSAFE for "cardboard and paper boxes for storing gowns after dry cleaning." The Examining Attorney argued that the mark BRIDAL KEEPSAFE was merely descriptive because the applicant's boxes were used to keep bridal gowns safe. However, the Board found the mark suggestive (pages 4-5):

[A]lthough these individual elements "bridal," "keep" and "safe" have some descriptive significance, we cannot say, based on the meanings of the individual words, that the combination BRIDAL KEEPSAFE is merely descriptive of applicant's goods. . . . In this case, some degree of thought or imagination must be used to get from BRIDAL

KEEPSAFE to the concept "keeps bridal gowns safe," a phrase which would, of course, be merely descriptive of applicant's boxes. That is, there is an element of incompleteness which we believe an individual encountering the mark must interpret in order to arrive at the conclusion that applicant's boxes are used for holding wedding gowns after cleaning.

Applicant submits that this same rationale applies in determining the registerability of the mark PURCHASE REWARDS and that the same degree of information is required by consumers in relation to this mark, as is required by customers to perceive the meanings of the marks in the cases cited above. Because Applicant's mark consists of a composite mark in connection with Applicant's services, whose import cannot be grasped without a "mental pause," the mark as a whole is suggestive rather than merely descriptive.

A Descriptive Connotation Does Not Preclude a Mark From Being Suggestive

It is well established that suggestiveness is not a bar to registration on the Principal Register. In this regard, T.M.E.P. § 1209.01(a) provides in pertinent part: "a designation does not have to be devoid of all meaning relative to the goods or services to be registrable." It is not prohibited that a mark have the capacity to draw attention to what the product is or what its characteristics are. The C.C.P.A. has held that a suggestive, and therefore registrable, mark may even go so far as to possess a "descriptive connotation" that conveys an impression of the goods. "The simple presence of that type of descriptive connotation, like the presence of suggestiveness, will not preclude registration where the mark is not merely descriptive of the goods." The Coca-Cola Co. v. Seven-Up, Co., 497 F.2d 1351, 182 U.S.P.Q. 207, 209 (C.C.P.A. 1974) (holding UNCOLA not merely descriptive of noncola soft drinks). Thus, even if Applicant's mark does arguably convey an impression of Applicant's services, or the characteristics thereof, by virtue of a "descriptive connotation," the Coca-Cola case makes it clear that such a connotation shall not preclude registration of the mark. In fact, "often the best trademarks are highly suggestive, and it is well settled that a valid trademark may be highly suggestive." Minnesota Mining and Mfg. Co. v. Johnson and Johnson, 172 U.S.P.Q. 491, 492 (C.C.P.A. 1972).

Doubt is Resolved in Favor of Publication

Any doubts as to the mere descriptiveness of a term are to be resolved in Applicant's favor and in favor of publication of the mark for opposition. See In re Grand Forest Holdings Inc., 78 U.S.P.Q.2d 1152 (T.T.A.B. 2006); In re Grand Metro. Foodservice Inc., 30 U.S.P.Q.2d 1974 (T.T.A.B. 1994). "Where reasonable men may differ, it has been the practice to resolve such doubt in an applicant's behalf and publish the mark for opposition." In re The Gracious Lady Serv., Inc., 175 U.S.P.Q. 380, 382 (T.T.A.B. 1972). Accordingly, because there is at least some significant doubt in this case as to the mere descriptiveness of Applicant's applied-for mark, Applicant respectfully requests that the Examining Attorney withdraw the refusal and approve the application for publication.

The Mark is Entitled to Registration

Finally, Applicant notes that even if the Examining Attorney does not accept Applicant's arguments set forth above, Applicant submits that the mark is entitled to registration on the Supplemental Register.

Conclusion

Applicant submits that it has responded to all issues raised in the Office Action. If the Examining Attorney has any questions, he is encouraged to contact the undersigned.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 035 for PROVIDING AN ELECTRONIC COMPUTER DATABASE TO ENCOURAGE CUSTOMERS TO MAKE ADDITIONAL PURCHASES AT THE POINT OF TRANSACTION

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed: Class 035 for providing an electronic computer database for use by retail store operators at the point of return or the point of transaction to enable the retailer to determine based upon the customer's return history, purchase history and returned items, whether the customer should receive a special offer that encourages the customer to continue shopping at the retail store or return to the store at a later time

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)**Declaration Signature**

I hereby elect to bypass the submission of a signed declaration, because I believe a declaration is not required by the rules of practice. I understand that the examining attorney could still, upon later review, require a signed declaration.

Request for Reconsideration Signature

Signature: /Stacey R. Halpern/ Date: 03/03/2009

Signatory's Name: Stacey R. Halpern

Signatory's Position: Attorney of Record, California Bar Member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

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